

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/405,659	02/27/90	KONO	S AT5032

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35M1/0414

EXAMINER	
L LIVING	
ART UNIT	PAPER NUMBER
	29

DATE MAILED: 3502

04/14/94

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Notice of Non-entry of Amendment

The Amendment filed on February 15, 1994 has not been entered because the amended claim 11 or new claims 19-26 are not directed to the same subject matter as the appealed claims 11-16 and 18. See MPEP 1214.01.

At the outset, on pages 14 and 15 of the Board decision, the Board stated that claims 11-16 and 18 are rejected under 35 USC 103 over Numata reference in view of the prior art admissions concerning the axial run-out. Note that "the appellant may amend the claims involved, or substitute new claims to avoid the art or reasons adduced by the Board. Such amended or new claims must be directed to the same subject matter as the appealed claims. The new ground of rejection raised by the Board does not reopen the

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prosecution except as to the subject matter to which the new rejection was applied." MPEP 1214.01 supra. Therefore, the applicant should amend the claims drawn to the axial run-out feature only. The new structural limitations such as: a first portion of the fly wheel body in claim 11, a fastening means in claim 19, a second fastening means in claim 20, an abutting surface in claim 21, a cylindrical portion and an outward flange in claim 23, a wall thickness in claim 25, etc., reopen the prosecution outside the subject matter of the axial run-out feature of the Board rejection under 37 CFR 1.196(b).

On the other hand, new claims 19-26 are not substitute new claims set forth under MPEP 1214.01 supra because applicant does not cancel a corresponding number of finally rejected claims. These new claims plainly require reopening of the prosecution beyond the subject matter of the new ground of rejection of the Board.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Luong whose telephone number is (703) 308-2168.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168.

Luong

April 12, 1994



VINH T. LUONG
PRIMARY EXAMINER
ART UNIT 352